

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed May 5, 2005. At the time of the Office Action, Claims 1-32 were pending in the Application. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 102 Rejection

The Examiner rejects Claims 1-6 and 8-32 under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2004/0266426 issued to Marsh et al. (hereinafter “*Marsh*”). This rejection is respectfully traversed for the following reasons.

Applicant respectfully reminds the Examiner that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.¹ In addition, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claims” and “[t]he elements must be arranged as required by the claim.”² In regard to inherency of a reference, “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.”³ Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.⁴

As amended, Independent Claim 1 recites an apparatus that includes “a signaling pathway [that] is established between the IP PBX and the mobile station via the cellular data network in response to the request, the establishment of the signaling pathway being substantially concurrent with the establishment of one or more of the voice circuits such that one or more features associated with a private network are delivered to the mobile station during the communication session.” There is nothing in *Marsh* that offers such a signaling

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.

² *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP §2131 (*emphasis added*).

³ MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis in original*)).

⁴ MPEP §2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. at App. and Inter. 1990) (*emphasis in original*)).

pathway teaching. Indeed, there is no disclosure in *Marsh* that espouses two separate pathways for information (i.e. voice and signaling), as outlined by Independent Claim 1. For this limitation, the Examiner general directs Applicant to numerous FIGURES, but after reviewing these FIGURES it is apparent that none can fill this missing void.

Turning to this supporting reference in more detail, *Marsh* discloses an architecture that extends a local area phone system to a wide area network, but an architecture that does not provide for separate call legs for voice and signaling. Note that the establishment of the signaling pathway should be substantially concurrent with the establishment of the voice circuits in order to deliver the features of the private network, as circumscribed by Independent Claim 1.

To comprehend the disparate teachings of *Marsh*, it is worthwhile to study its operations thoroughly. In contrast to the subject matter of Independent Claim 1, *Marsh* provides: "In block 700, the VoIP phone 156 sends a SIP invitation message specifying the PBX telephone number or other identifier such as the SIP URL or IP address of the dual mode subscriber device 130. The soft switch 344 receives the invite and responds with a SIP trying message in block 702. In block 704, the soft switch 344 reviews the call processing information associated with the dual mode subscriber device 130 such as the user-defined settings as well as registration information. The soft switch 344 determines to contact the dual mode subscriber device 130 in the cellular network. In block 706, the soft switch 344 sends a SIP invitation message to the dual mode subscriber device 130 over the data-bearing path of the cellular network, such as the path 150 of FIG. 6. The soft switch 344 identifies the dual mode subscriber device 130 using standard IP addressing techniques. In block 708, the subscriber device responds by sending a SIP ringing indication message. In block 710, the dual mode subscriber device 130 accepts the call. Alternatively, this response is automatic and the call is accepted by the dual mode subscriber device 130 at some other point in the call flow such as at block 730. In either case, the dual mode subscriber device 130 responds by sending a SIP OK message to the soft switch 344 in block 712.

To command the media gateway 340 to initiate the voice-bearing traffic channel, the soft switch 344 creates an IP message for transmission over the IP network to the media gateway 340, such as over the legs 342A and 342B. The message indicates an initiation of a call over the cellular network to the dual mode subscriber device 130 designated by its

cellular telephone number. As such, in block 714, the soft switch 344 sends an IAM message or like call initiation message in IP format over the IP backbone 108 to the media gateway 340 designating the dual mode subscriber device 130 by its cellular telephone number.

In block 716, the media gateway 340 receives the IP formatted message and, in response, signals a call establishment attempt to the legacy MSC 140, such as over the leg 342C, using one of a variety of standard PSTN signaling protocols. In this case, the media gateway 340 sends an ISUP IAM. In block 718, the legacy MSC 140 responds with an ACM. The message is received by the media gateway 340 and, in block 720, the media gateway 340 creates a corresponding IP formatted message and sends it to the soft switch 344 over the IP backbone 108.

In response to block 716, the legacy MSC 140 initiates a cellular call in block 722 according to well-known practices. In block 730, the dual mode subscriber device 130 automatically accepts the call if it has already been accepted in block 710. Also in block 730, the dual mode subscriber device 130 correlates the incoming cellular voice call with the previously received SIP invitation. The dual mode subscriber device 130 responds with a cellular call accept in block 732. In turn, the legacy MSC 140 responds with an ANM to the media gateway 340 in block 734. The media gateway 340 responds to the soft switch 344 with an IP message with the ANM message information in block 736. These PSTN blocks can occur before, after or in parallel with the SIP blocks just described.

Meanwhile, the soft switch 344 responds to the VoIP phone 156 with a SIP ringing indication message in block 724. The soft switch 344 sends a first create connection message to the media gateway 340 in block 726. The first create connection message instructs the media gateway 340 to allocate resources to the VoIP audio path to be used in block 728 and later in block 742. The MGCP is used in this example although other protocols could be used such as Megaco or other media gateway control protocols. In a logical sense, the media gateway 340 establishes a unidirectional VoIP voice-bearing path from the media gateway 340 to the VoIP phone 156 in block 728 and voice-bearing packets begin to stream from the media gateway 340 to the VoIP phone 156.” (See *Marsh* at Column 14, paragraphs 145-149.)

Thus, evaluating *Marsh* more carefully reveals that it does not provide the *separate* signaling pathway configuration for delivering features to the mobile station: much less a

signaling pathway being established concurrently with the voice circuits. Because such a limitation is outlined in Independent Claim 1, Independent Claim 1 is easily allowable over *Marsh*. Note that the Examiner should appreciate the significance of a separate signaling pathway in an arrangement that is highlighted by the pending subject matter. The configuration of the present invention allows the enterprise system to establish a voice path between the private and public network using a voice network. The separate signaling path may enable enhanced signaling to deliver private network information to the mobile station by establishing a data connection from the IP PBX and the mobile station.

Therefore, while in the public wireless network, the mobile station is able to receive private network PBX features (e.g. shared lines, call pickup, group pickup, directory functions, message waiting indicator, etc.) as if the mobile station were part of the IP PBX in the private network. This allows the enterprise system to provide a common set of private network features to the mobile station regardless of whether the mobile station receives service from the private or public network. Such a scenario could not be facilitated without a separate signaling pathway, which is not trivial nor insignificant. This feature further provides that a given end user does not sacrifice processing time or inhibit his own versatility in being able to enjoy the advantages of both systems. In addition, minimal overhead is incurred as a result of a modification to a given system in order to accommodate private and public network functions.

For at least these reasons, Independent Claim 1 is clearly patentable over *Marsh*.

Section 103 Rejection

The Examiner rejects Claim 7 under 35 U.S.C. §102(e) as being anticipated by *Marsh*. This rejection is respectfully traversed for the following reasons.

Applicant respectfully reminds the Examiner that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.⁵

It is respectfully submitted that the rejected claims are patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation of the Independent Claims. This issue has been evaluated extensively in the §102 analysis above. The proposed *Marsh* combination is flawed in that there is simply no disclosure of any separate signaling pathway, which is established substantially concurrent with the establishment of the voice circuits.

In addition, Independent Claims 8, 15, 21, and 27 recite a similar (but not an identical) limitation and, thus, are also allowable over this §103 combination using a similar rationale. Additionally, using analogous reasoning, the corresponding dependent claims of these Independent Claims are also allowable over the references of record.

Accordingly, all of the pending claims have been shown to be allowable, as they are patentable over the cited references. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

⁵ See M.P.E.P. §2142-43.

ATTORNEY DOCKET NO.
062891.1175

PATENT APPLICATION
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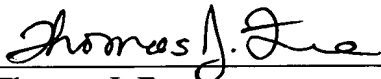
CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. However, if this is not the case, the Commissioner is hereby authorized to charge any amount required or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas Frame at 214.953.6675.

Respectfully submitted,
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Date: June 6th, 2005

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